UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/653,696	DAVIS ET AL.
	Examiner	Art Unit
	Robert B. Harrell	2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>12 April 2007</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>2-4</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>2-4</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>03 September 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☒ Other: *see attached Office Action.*

1. Claims 2-4 remain presented for examination.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks ™, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor. Also, the applicant is reminded of the provision of 37 C.F.R. 1.121 with respect to the manner in which amendments to the claims in the claim index shall be provided by the applicant in his responses (i.e., claim 4 is not "New" it is -Currently amended-).

4. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on **http://portal.uspto.gov/external/portal/pair**)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

6. ***Claims 2, 3, and 4 rejected under 35 U.S.C. 102 (b)*** as being anticipated by MacWeek "Navigator tricks raise concerns." As submitted by the applicant on 13 February 2006 Information Disclosure Statement (IDS).

7.   Per claim 2, MacWeek taught a method for monitoring the use of a resource by a client (owner of a Netscape browser) connected to a computer network (Internet) having one or more servers in communication with on or more clients (as is common with the Internet pre 18 March 1996), the method comprising:
a)   receiving at a client a first HTML document (a web page) identified by a first URL (web pages are accessed using a URL) from a first web server, the first HTML document comprising a link to one or more first instructions (JavaScripts)[since web pages pointed to one or more other web pages (embedded links) those other pages were anticipated to have the claimed instructions as well as the source web page per the Abstract);
b)   running, by the client, the one or more first instructions linked to by the first HTML document, the one or more instructions operative to cause the client to generate a first indication of the receipt of the first HTML document by the client (e.g., see Abstract "tracks a user's movement on the Web");
c)   receiving at the client a second HTML document identified by a second URL from a second web server, the second HTML document comprising a link to one or more second instructions (it was anticipated that a user did not navigate to just one Web Page and then dispose of the computer in the garbage, forever, but continued to "surf" to other web pages as indicated in (a) above and thus repeated (a) above);
d)   running, by the client, the one or more second instructions linked to by the econd HTML document, the one or more second instructions operative to cause the client to generate a second indication of the receipt of the second HTML document by the client (e.g., see Abstract "tracks a user's movement on the Web"); and
e)   transmitting the first indication and the second indication to a server (e.g., see Abstract).

8. Per claims 3 and 4, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. In summary, a client would implement a URL to obtained a web page (i.e., a home page). That web page would have therein a URL to other web page(s) which contained JavaScript which generated indication(s) of receipt of web pages thus generating an indication of the navigation by the client in the form of a tracking method that sent to one or more servers a navigation history of the client. It is noted that JavaScript are still "linked" even if be within the same linking web page and thus "link" in claim 1 (line 5 as an example) encompasses linking to instruction within the same web page and thus reads on the MacWeek.

9.   The rejections, and grounds for rejections, under 35 U.S.C. 102(b) as presented in examiner's prior Office Action mailed 12 October 2006, are hereby maintained and incorporated in this Office Action by reference.

10. A rejection for anticipation requires that the four corners a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), it is only necessary for the claims to read on something disclosed in the prior art reference or fully met by it. See also Atlas Powder Co. v. IRECO Inc., 190 F.3d at 1346, 51 USPQ2d at 1945 (Fed. Cir.1999) (quoting Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 781, 227 USPQ 773, 778 (Fed. Cir. 1985)).

11. The applicant argued the rejection and ground for rejection under 35 U.S.C. 102(b) in his 12 April 2007 response by stating in substance that:
a) MacWeek presents a discussion of the inclusion of support for JavaScript and Cookies in Netscape Communications Corp.'s Netscape Navigator 2.0 browser application. Although it is unclear as to the specific portions of MacWeek upon which the Examiner is relying, the applicants are of the position that the only relevant portions of MacWeek are those discussing JavaScript and not Cookies, which are client-side persistent data objects, not instructions as claimed. With regard to JavaScript, MacWeek discusses that JavaScript is suited to performing a range of tasks, from scrolling text to launching an applet. MacWeek also discusses the reported use of JavaScript to retrieve a user's e-mail address, real name and activity from the Netscape cache file, which documents a user's movements on the Web. Finally, MacWeek discusses the use of JavaScript to create an agent that checks every second to see what page a user is on, automatically forwarding this information back to a server. Contrary to the Examiner's conclusion, the applicants respectfully assert that MacWeek fails to identically disclose, teach or suggest the elements of the pending claims. *However*, MacWeek identically disclosed, taught and suggested each of the elements of the pending claims as indicated above as herein repeated;
b) each of independent claims includes a variant of the step of running instructions linked to by a web page to generate (or generating) an indication of receipt of an HTML page or navigation by a client to a given web page. Indeed, MacWeek is silent with regard to using instructions to generate information. *However*, so are the claims silent with regard to using instructions to generate information other then first and second instructions cause the client to generate indications of receipt of the HTML documents by the client as claimed which matches MacWeek's disclosure of "JavaScripts can be sent to a browser when a page is requested. The scripts then perform a range of tasks, such as launching an applet or scrolling text. However, these capabilities can be used for more insidious uses, such as obtaining a user's e-mail address, name and information from the Netscape cache file, which tracks a user's movement on the Web." and "HTTP Cookie stores information for reuse at a specific site, such as passwords and method-of-payment data. When users return to these sites, their log-in information is supplied automatically. Although HTTP Cookie information is supposed to be read only by the site that created it, researchers have discovered that it can be accessed and used to track clients' moves." and "JavaScripts can be sent to a browser whenever a particular page is requested. These scripts can perform a range of tasks from scrolling text to launching an applet. However, in between these mostly harmless functions are capabilities that some say border on invasion of privacy. For example, several Webmasters have reported using JavaScript to retrieve a user's

e-mail address, real name and activity from the Netscape cache file, which documents a user's movements on the Web." and "For example, John Robert LoVerso, a researcher at the Open Software Foundation's Research Institute in Cambridge, Mass., used JavaScript to create an agent that checks every second to see what page a user is on, automatically forwarding this information back to his server." In short, when a client received one or more HTML Web Page(s), a JavaScript of executable instructions were sent to the client and run on the client to generate navigation indications (i.e., track user's movements on the Web).

c) one example that MacWeek provides discusses the collection of information already residing on the client (e.g., from the Netscape cache file), which is inconsistent with the generation of information. The second example that MacWeek provides is ambiguous with regard to how the JavaScript obtains information that identifies what page a user is on. The applicants assert that there is no teaching beyond examination of the browser cache to retrieve already existing information with regard to page navigation. Indeed, this second example teaches away from the present claims in that the JavaScript is resident on the client and not linked to by a web page. *However*, as indicated above, when a client received one or more HTML Web Page(s), a JavaScript of executable instructions were sent to the client and run on the client to generate navigation indications (i.e., track user's movements on the Web). That is, a client would receive a URL of an HTML document as identified by the received URL such as to navigate to that Web Page HTML document that had therein embedded or linked JavaScripts which when run by the client would monitor the clients navigation movement on the Web and send the monitored navigations to a server.

12. **The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:**

a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between **the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligations under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102 (f) or (g) prior art under 35 U.S.C. 103.

14.   ***Claims 2, 3, and 4 are rejected under 35 U.S.C. 103(a)*** as being unpatentable over MacWeek "Navigator tricks raise concerns." As submitted by the applicant on 13 February 2006 Information Disclosure Statement (IDS) for the reasons given above since that which was anticipated was also obvious. Thus it would have been obvious for a client to obtain a "home page" that linked to other web pages that had a navigation history tracking JavaScript in the manner disclosed by MacWeek.

15.   The rejections, and grounds for rejections, under 35 U.S.C. 103(a) as presented in examiner's prior Office Action mailed 12 October 2006, are hereby maintained and incorporated in this Office Action by reference.

16.   Obviousness from a prior art reference would follow, ipso facto, if prior art reference anticipates. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984), citing In re Kalm, 378 F.2d 959, 962, 154 USPQ i0, 12 (CCPA 1967), (anticipation stated as being the "epitome of obviousness").   Also, the question is not whether the combination was obvious to the applicant but whether the combination was obvious to a person with ordinary skill in the art (KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. (United States Supreme Court (Decided April 30, 2007))).

17.   The applicant argued the rejection and ground for rejection under 35 U.S.C. 103(a) in his 12 April 2007 response by stating in substance that regarding the obviousness rejection, the applicants further assert that MacWeek fails to teach or suggest how the JavaScript agent operates and therefore does not enable one of skill in the art to arrive at the presently claimed invention. ***However***, so are the claims silent with regard to using instructions to generate information other then first and second instructions cause the client to generate indications of receipt of the HTML documents by the client as claimed which matches MacWeek's disclosure of "JavaScripts can be sent to a browser when a page is requested. The scripts then perform a range of tasks, such as launching an applet or scrolling text. However, these capabilities can be used for more insidious uses, such as obtaining a user's e-mail address, name and information from the Netscape cache file, which tracks a user's movement on the Web." and "HTTP Cookie stores information for reuse at a specific site, such as passwords and method-of-payment data. When users return to these sites, their log-in information is supplied automatically. Although HTTP Cookie information is supposed to be read only by the site that created it, researchers have discovered that it can be accessed and used to track clients' moves." and "JavaScripts can be sent to a browser whenever a particular page is requested. These scripts can perform a range of tasks from scrolling text to launching an applet. However, in between these mostly harmless functions are capabilities that some say border on invasion of privacy. For example, several Webmasters have reported using JavaScript to retrieve a user's e-mail address, real name and activity from the Netscape cache file, which documents a user's movements on the Web." and "For example, John Robert LoVerso, a researcher at the Open Software Foundation's Research Institute in Cambridge, Mass., used JavaScript to create an agent that checks every second to see what page a user is on, automatically forwarding this information back to his server." In short, when a client received one or more HTML Web Page(s), a JavaScript of executable instructions were sent to the client and run on the client to generate navigation indications (i.e., track user's movements on the Web).

18. ***Claims 2, 3, and 4 rejected under 35 U.S.C. 102 (e)*** as being anticipated by Blumenauer (United States Patent Number: 6,108,637).

19. Per claim 2, Blumenauer taught a method for monitoring the use of a resource by a client (e.g., see Title and Abstract) connected to a computer network (Internet) having one or more servers in communication with on or more clients (as is common with the Internet pre 18 March 1996 and per figures 6A-6D as examples), the method comprising:
a) receiving at a client a first HTML document, identified by a first URL (web page(s) to the client (e.g., see figures 2A-2D and/or 5A-5C and/or figure 6C (303) (web pages are accessed using a URL)), from a first web server, the first HTML document comprising a link to one or more first instructions ("Monitoring Instructions" per figures 5A-5C);
b) running, by the client, the one or more first instructions linked to by the first HTML document, the one or more instructions operative to cause the client to generate a first indication of the receipt of the first HTML document by the client (e.g., see figure 6D, and/or Abstract and/or col. 6 (line 43-et seq.)) receiving at the client a second HTML document identified by a second URL from a second web server, the second HTML document comprising a link to one or more second instructions (it was anticipated that a user did not navigate to just one Web Page and then dispose of the computer in the garbage, forever, but continued to "surf" to other web pages as indicated in (a) above and thus repeated (a) above);
d) running, by the client, the one or more second instructions linked to by the second HTML document, the one or more second instructions operative to cause the client to generate a second indication of the receipt of the second HTML document by the client (e.g., see Abstract); and
e) transmitting the first indication and the second indication to a server (e.g., see Abstract and/or figure 3C, and/or col. 9 (line 65-et seq.) as example(s)).

20. Per claims 3 and 4, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

21. ***Claims 2, 3, and 4 are rejected under 35 U.S.C. 103(a)*** as being unpatentable over Blumenauer (United States Patent Number: 6,108,637) As applied above and further in view of the following comments.

22. Obviousness from a prior art reference would follow, ipso facto, if prior art reference anticipates. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1446, 221 USPQ 385, 390 (Fed. Cir. 1984), citing In re Kalm, 378 F.2d 959, 962, 154 USPQ i0, 12 (CCPA 1967), (anticipation stated as being the "epitome of obviousness"). Also, the question is not whether the combination was obvious to the applicant but whether the combination was obvious to a person with ordinary skill in the art (KSR INTERNATIONAL CO. v. TELEFLEX INC. ET AL. (United States Supreme Court (Decided April 30, 2007))).

23. As indicated herein, JavaScripts can be internally linked and thus an HTML Web Page having a JavaScript (or applet) therein also links to that JavaScript (or applet). Moreover, Blumenauer taught of recursive navigation and thus when a client sent a URL to a server for an first HTML Web Page, such obviously contained links to other HTML Web Pages which they

inurn could obviously have had the monitoring programming and thus by link from one HTML Web Page to another having the monitoring program would have been encompassed, obviously, by the applicant's defined invention in the claims. In like turn, a client could obviously have navigated to the site having the monitoring program from a previous HTML Web Page document which document being the first and/or second claimed HTML Web Page document provided by a server in response to a URL request from the client.

24. Per claims 3 and 4, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

25. The following is a quotation of the second paragraph of 35 U.S.C 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

26. **_Claims 2, 3, and 4 are rejected under 35 U.S.C 112, second paragraph_**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, in claim 2 (lines 4-5) recites "receiving at a client a first HTML document identified by a first URL from a first web server". However, it cannot be clearly ascertained if the client receives an HTML document from a server based on a URL sent

to the server (i.e., receiving at a client a first HTML document$_2$ identified by a first URL$_2$ from a first server) or if the server sends a URL to the client which in turn is then implemented to fetch the HTML document (i.e., receiving at a client a first HTML document identified by a first URL from a first server).

27. *A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).*

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Thursday from 5:30 am to 2:00 pm.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (571) 273-8300.

30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142